

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Scheller, D. *et al.*
Serial No.: 10/587,637
Filed: February 6, 2007
Title: (S)-2-N-PROPYLAMINO-5-HYDROXYTETRALIN AS A D3
AGONIST
Group Art Unit: 4161
Examiner: C.D. Ricci
Confirmation No.: 2828
Docket No.: 6102-000034/US/NP
Client Ref.: P/Sche/III/7/03

SUBMITTED ELECTRONICALLY VIA EFS-WEB

September 23, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO OFFICE ACTION DATED AUGUST 8, 2008

This paper is responsive to the Office Action dated August 8, 2008 in the above referenced application, in which a shortened statutory period of one month was set for reply. Applicant hereby makes petition for extension of time of one (1) month in which to submit the present response. Authorization is provided herewith to charge the fee required under 37 C.F.R. §1/17(a)(1) to Deposit Account No. 08-0750.

By the present Action, Applicant is required under 35 U.S.C. §121 to restrict the application to one of the following groups:

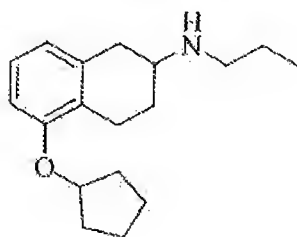
- I. Claims 10-14 and 19-21;
- II. Claims 15-18.

Applicant provisionally elects with traverse the invention of Group I, embodied in Claims 10-14 and 19-21 which are drawn to compounds and compositions.

The Examiner states that the inventions listed as Groups I and II do not relate to a

single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they allegedly lack the same or corresponding technical feature. In making this restriction, the Examiner asserts that the "compound of Claim 19" [*sic*; compounds embraced by Claim 19 understood] allegedly does not represent a contribution over the prior art, based van Vliet *et al.* (1996) *J. Med. Chem.* 39:4233-4237), hereinafter "van Vliet". Applicant respectfully disagrees and submits that compounds of Claim 19 are in fact not obvious over van Vliet for at least the reasons discussed below.

The Examiner states that one of ordinary skill in the art would have been motivated to substitute *c*-C₅H₉ (Applicant assumes *O*-*c*-C₅H₉ is meant, as the present claims require the presence of an oxygen atom in the general formula) for methoxy to arrive at a compound embraced by Claim 19. However, even if (which is not admitted herein) one of ordinary skill in the art would have been motivated to substitute *O*-*c*-C₅H₉ for methoxy as the Examiner suggests, such a modification would not result in a compound embraced by Claim 19. Specifically, modification of Example 4 of van Vliet as proposed by the Examiner would result in the following structure, which does not fall within the present Claim 19.



Compound resulting from Examiner's proposed modification

The Examiner has therefore failed to show that Groups I and II do not share a special technical feature. On the contrary, Applicant submits that the inventions of Groups I and II relate to a single inventive concept and respectfully requests withdrawal of the present restriction requirement. In further support of this request, Applicant notes that no unity of invention rejection was made in the International Preliminary Examination Report dated November 18, 2005 in International Application No. PCT/EP2004/014143, of which the present application represents the national stage under 35 U.S.C. §371. Applicant notes that, even if restriction between Groups I and II is maintained in spite of Applicant's traverse

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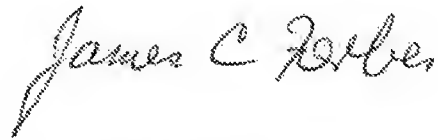
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herein, process claims that depend from or otherwise require all limitations of an allowable product claim, or are amended to depend from or otherwise require all limitations of an allowable product claim, will be considered for rejoinder.

If personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number below.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

A handwritten signature in cursive script, reading "James C. Forbes". The signature is written in dark ink and is positioned above the printed name and contact information.

James C. Forbes
Agent for Applicant
Reg. No. 39,457
Tel. 847-412-6350